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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/639,083	08/16/2000	Peter Hueniken	051481-5053	3067

9629 7590 08/29/2003

MORGAN LEWIS & BOCKIUS LLP  
1111 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20004

EXAMINER
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PRASAD, CHANDRIKA

ART UNIT	PAPER NUMBER
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2839

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/639,083

Applicant(s)

HUENIKEN ET AL.

Examiner

Chandrika Prasad

Art Unit

2839

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The reply filed on 7/30/03 consists of amendments to claims 2, 13, addition of new claims 16-19 and remarks related to rejection of claims. The claims are not allowable as explained below.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the mounting member must be shown and identified by a reference number or the feature(s) canceled from the claims 16-19. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 16-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The independent claim 16 recites a mounting member, which has been neither described in the specification nor shown in the drawing. Support for this feature on Page 4, lines 26-27 or Page 5, lines 23-26 as alleged in the remarks was not found.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- The independent claims 1, 2, and 11-13 recite the limitation "the first member" in line 6. There is insufficient antecedent basis for this limitation in the claims.
- The independent claim 1, line 13; claim 2, line 14; claim 11, line 12; claim 12, line 16 and claim 13, line 16 recite the limitation "the second member". There is insufficient antecedent basis for this limitation in the claims.
- The independent claims 1, 2, 11, 12, 13, 15 and 16 recite projections and groove extending parallel to a plane and/or axis. Only a line can be parallel to axis and a line, or a surface can be parallel to a plane. The projections and the grooves have three dimensions. It is not clear what portion of the projections or the groove is parallel to the axis or the plane.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 6-10, 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Mouissie (EP 0 415 489).

Mouissie (Figure 3) show a system for connecting a male member 1 to a female member 4 with both members displaceable along an axis lying in a plane, the male member having a pair of first projections 3 each with one end fixed to the male member and the other end resiliently movable relative to the male member and having a protrusion 9 at its tapered tip. Each of the projections 3 has a pair of first faces. The female member has a pair of C-shaped grooves (not numbered, each groove having a larger groove portion in communication with a smaller groove portion) with cavities wherein the grooves have surfaces parallel to the axis, protrusions engage the cavities for latching the two members together and the grooves have side surfaces slidably confronting the first faces of the projection 3 to prevent relative displacement of two members perpendicular to the plane. The two members, when fitted together, have a common axis and centered about this common axis. The resiliency of the projections would absorb vibration. The protrusions 9 are visible through the cavities.

***Allowable Subject Matter***

9. Claims 3-5 and 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Claims 2, 11 and 13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

11. The following is a statement of reasons for the indication of allowable subject matter:

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Mouissie does not show a second projection as required by Claim 2 or a second pair of projections as required by claims 11 and 13 with sliding engagement with the groove.

***Response to Arguments***

12. Applicant's arguments filed 7/30/03 have been fully considered but they are not persuasive. Since Mouissie shows the structure as claimed, vibration damping is inherent.

***Contact Information***

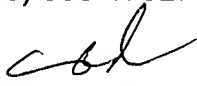
14. Any correspondence to this action may be mailed to:

**Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450**

Hand-delivered responses should be brought to:

**Crystal Plaza 4, Fourth Floor (receptionist)  
2201 South Clark Place, Arlington, Virginia**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chandrika Prasad at (703) 308-0977. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild, can be reached at (703) 308-2710. The fax number for this Group is (703) 872-9318 (general) and (703) 872-9319 for after-final. Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-1782.

  
Chandrika Prasad  
Patent examiner  
August 27, 2003